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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/804,756      | 03/19/2004  | Keishi Tamura        | 16869P-022010US     | 7684             |

20350 7590 10/04/2006

TOWNSEND AND TOWNSEND AND CREW, LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

EXAMINER

VEILLARD, JACQUES

ART UNIT PAPER NUMBER

2165

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                      |  |
|------------------------------|--------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/804,756 | <b>Applicant(s)</b><br>TAMURA ET AL. |  |
|                              | <b>Examiner</b><br>Jacques Veillard  | <b>Art Unit</b><br>2165              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 34-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to the applicant's communication filed on 3/19/2004.
2. The preliminary amendment filed on March 19, 2004 has been entered.
3. Claims 1-33 have been canceled, and claims 34-50 have been added as new.
4. Claims 34-50 are pending and presented for examination.

### ***Information Disclosure Statement***

5. There is no information disclosure statement filed with the application.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 49-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 49 recites the limitation "said first and second microprocessors" in line 11. There is insufficient antecedent basis for this limitation in the claim. It is unclear to the examiner to what microprocessors the applicant(s) is/are referred to. Appropriate correction or deletion is required.

Claim 50 is at least rejected for its dependency directly on the rejected claim 49.

### ***Double Patenting***

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7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 34-50 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 and 23-24 of U.S. Patent No. 6,728,848.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are broader than claims 1-15 and 23-24 of the U.S. patent No. 6,728,848 which encompasses the same metes, bounds, and limitations. It is noted that the subject matter claimed in the instant application is fully disclosed in the referenced U.S. patent No. 6,728,848 and would be covered by any patent granted on that patent since the referenced U.S. patent and the instant application are claiming common subject matter. Therefore, they are not patentably distinct from each other because of the following reasons: claim 44 of the instant application substantially recites the limitations of claim 11 of the cited U.S. patent No. 6,728,848. The claim merely adds certain underlined and bolded limitations as shown in comparison of the table below.

| Application claim 44   | U.S patent claim 11   |
|--|---|
| <p>44. A system for server free back up of information on a network comprising:</p> <p>a storage system;</p> <p>a plurality of backup systems; and</p> <p>a server system configured to send a command to backup data from the storage system to one of the plurality of backup systems;</p> <p>wherein said command to backup includes information of a destination device target port of the backup system to receive the data, and wherein said storage system is configured to receive said command <b><u>through a target port of said storage system</u></b></p> <p>to backup by a first processor of the storage system, and to determine an initiator port from a plurality of initiator ports of the storage system from which to send said data <b><u>through an initiator port of said storage system</u></b></p> | <p>11. A system for server free back up of information on a network comprising:</p> <p>a storage system;</p> <p>a plurality of backup systems; and</p> <p>a server system configured to send a command to backup data from the storage system to one of the plurality of backup systems;</p> <p>wherein said command. to backup includes information of a destination device target port of the backup system to receive the data, and wherein said storage system is configured to receive said command</p> <p>to backup by a first processor of the storage system, and to determine an initiator port from a plurality of initiator ports of the storage system from which to send said data</p> |

|  |  |
|--|--|
| by a second processor of the storage system,<br>based on said command to backup. | by a second processor of the storage system,<br>based on said command to backup. |
|--|--|

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify cited limitations as indicated claim 44 of the instant application since the omission and addition of the cited limitations would have not changed the process according to which the system for server free back up of information on a network. Therefore, the ordinary skilled artisan would be also motivated to modify claim 44 of the instant application by deleting the use of through a target port of said storage system ... and through an initiator port of said storage system, since it has been held that omission of an element and its function and a combination where the remaining elements perform the same functions as before involves only routine in the art. See in re Karlson, 136 USPQ 184 (CCPA 1963).

The dependent claims 45-48 of the instant application are at least rejected for their dependencies directly or indirectly on the rejected claim 44 above.

8. As per claims 34-43 and 49-50 of the instant application, they are rejected under the same analysis for claim 44 with respect to claims 1-10 and 23-24 of the U.S patent No. 6,728,848, since they are broader than claims 1-10 and 23-24 of the U.S patent.

***Prior Art Made of Record***

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9. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. U.S. patents and U.S. patent application publications will not be supplied with Office actions. Examiners advises the Applicant that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)), from the Office of Public Records and from commercial sources. For the use of the Office's PAIR system, Applicants may refer to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.

#### *Conclusion*

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacques Veillard whose telephone number is (571) 272-4086. The examiner can normally be reached on Mon. to Fri. from 9 AM to 4:30 PM, alt. Fri. off..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272- 4146. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

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like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

J.V.  
J.V.

Jacques Veillard  
Patent Examiner AU 2165

September 27, 2006

  
CYNTHIA ROBINSON  
PRIMARY EXAMINER